

REMARKS

Applicants respectfully request reconsideration of the subject application. This Amendment is submitted in response to the Office Action mailed April 18, 2006. Claims 1-23 stand rejected. In this Amendment, claims 1 and 19 have been amended, and claims 24-28 have been cancelled. No new matter has been added.

35 U.S.C. § 101 Rejections

The Examiner has rejected claims 1-15 and 17-23 under 35 U.S.C. § 101 because the claimed invention is directed to non-statutory subject matter. Applicants have amended claim 1. Applicants, accordingly, respectfully request withdrawal of the rejections of claims 1-15 and 17-23 under 35 U.S.C. § 101 because the claimed invention is directed to non-statutory subject matter.

35 U.S.C. § 112 Rejections

The Examiner has rejected claims 1-23 under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention.

The Examiner asks how many lanes are in the scope of claim 1 and asserts that at least two lanes are required. Applicants disagree. Any number of lanes are within the scope of the claim. If one lane falls within the origination area and

destination area and the transport value exceeds the predetermined amount (e.g., is viable), only one lane may be included in the lot. However, if the transportation value does not exceed the predetermined amount, any number of lanes may be included, as defined by the claim limitations, until the transportation value of the lanes exceeds the predetermined amount.

The Examiner asserts that the claim scope of claims 17 and 18 is unclear. Claim 17 indicates that when a lane is added to a lot, the lane may be removed from the database that includes the lanes. Claim 18 indicates that when a lane is removed from a lot, it may be added to the database (e.g., returned to the database if it had been previously removed).

Claim 19 has been amended.

Applicant, accordingly, respectfully requests withdrawal of the rejections of claims 1-23 under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention.

35 U.S.C. § 103 Rejections

The Examiner has rejected claims 1-23 under 35 U.S.C. § 103(a) as being unpatentable over the article “Business-to-Business online auctions: key issues for purchasing process improvement” (hereinafter “Business”).

Business discloses existing online auctions directed to goods and services. In these online auction systems, lots are sometimes created for bidding. During the online auction, suppliers can bid on the various lots according to their capabilities.

Business lacks, *inter alia*, the limitations of claim 1: “creating an origination area; creating a destination area; compiling all lanes having origination locations falling within the origination area and destination locations falling within the destination area; increasing at least one of the origination area and the destination area of the lot to include more lanes within the lot until the total of the transport value of all lanes included within the lot exceeds a predetermined amount.”

The Examiner admits that Business does not explicitly disclose the above limitations. The Examiner asserts that the above limitation is obvious based on certain teachings of Business, common sense, and logistics. Applicants respectfully disagree.

Business may recognize the use of an auction system for transportation services; however, Business does not disclose implementation of an auction system for transportation services. In particular, Business does not disclose a method of creating lots for transportation services.

Business, in fact, discloses that "It is critical that lotting be performed very well as it helps suppliers recognize which parts fit their core competencies and creates the foundation for successfully online auctions." Thus, the cited art recognizes the importance of creating a lot for each particular type of supplier.

Embodiments of the presently claimed invention are directed to a method of creating a lot for transportation services.

Although the Examiner has pointed to the disclosure in Business, common sense and logistics in supporting the obviousness rejection, there is no reasonable expectation of success that these disclosures would lead to effective lot creations for transportation services based on the disclosure of Business.

Moreover, the cited art fails to disclose how to create a lot for transportation services. The Examiner has, therefore, pointed to no teaching in the art for all of the claimed limitations.

Accordingly, Applicants respectfully submit the Examiner has failed to make a *prima facie* case of obviousness.

The Examiner has rejected claims 1-23 under 35 U.S.C. § 103(a) as being unpatentable over the article Business in view of "The Stamp Center."

The Stamp Center is directed to an advertisement for dutch country auctions, which include lots having minimum lot values. The Stamp Center disclose that the auction organizers researches, catalogues, describes and logically presents materials to maximize results, and that some items will be lotted individually and others grouped depending on type of material, value and condition.

It is respectfully submitted that Business does not teach or suggest a combination with The Stamp Center and that The Stamp Center does not teach or suggest a combination with Business. It would be impermissible hindsight, based on applicants' own disclosure, to combine Business with The Stamp Center.

Furthermore, even if Business and The Stamp Center were combined, such a combination would lack, inter alia, the limitations of claim 1: "creating an origination area; creating a destination area; compiling all lanes having origination locations falling within the origination area and destination locations falling within the destination area; increasing at least one of the origination area

and the destination area of the lot to include more lanes within the lot until the total of the transport value of all lanes included within the lot exceeds a predetermined amount."

As discussed above, Business does not specifically disclose lotting transportation services. Similarly, The Stamp Center does not disclose lotting transportation services.

Further as discussed above, Business recognizes the criticality of optimal lotting in a bidding process.

The Stamp Center does not provide a disclosure for lotting transportation services or provide a reasonable expectation of success that a method of creating a lot as presently claimed as presently claimed based on the disclosures of Business and The Stamp Center.

Accordingly, Applicants respectfully submit the Examiner has failed to make a *prima facie* case of obviousness.

The Examiner submits certain limitations of claim 1 are inherent. Applicants respectfully disagree.

Applicants direct the Examiner to MPEP § 2112, which provides that "[a]n invitation to investigate is not an inherent disclosure' where a prior art reference 'discloses no more than a broad genus of potential applications of its discoveries.'

Metabolite Labs., Inc. v. Lab. Corp. of Am. Holdings, 370 F.3d 1354, 1367, 71 USPQ2d 1081, 1091 (Fed. Cir. 2004) (explaining that '[a] prior art reference that discloses a genus still does not inherently disclose all species within that broad category' but must be examined to see if a disclosure of the claimed species has been made or whether the prior art reference merely invites further experimentation to find the species.)

Business and The Stamp Center merely disclose a genus and do not inherently disclose all species within that broad category. A disclosure of an auction system, in general, has been made, and a mere invitation to experiment to provide an auction system that can accommodate transportation services is arguably provided in Business.

The Examiner also submits that certain limitations of claims 2-23 are inherent. Because claims 2-23 depend from claim 1, they are patentable for at least the same reasons as were discussed above for claim 1 and the Examiner's inherency argument is moot. Therefore, applicants are under no duty to address it here. Nonetheless, Applicants do not acquiesce to the Examiner's inherency argument. Moreover, Applicants reserve the right to address this argument in the future should a duty to do so arises.

Therefore, Business, The Stamp Center, and combinations thereof fail to teach or suggest all of the limitations of claim 1. Claims 2-23 depend, directly or indirectly, from independent claim 1. Applicant, accordingly, respectfully requests withdrawal of the rejections of claims 1-23 under 35 U.S.C. § 103.

Applicants respectfully submit that the present application is in condition for allowance. If the Examiner believes a telephone conference would expedite or assist in the allowance of the present application, the Examiner is invited to call Jennifer Hayes at (408) 720-8300.

Please charge any shortages and credit any overages to Deposit Account No. 02-2666. Any necessary extension of time for response not already requested is hereby requested. Please charge any corresponding fee to Deposit Account No. 02-2666.

Respectfully submitted,
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